

REMARKS

Claims 1-12, 15, 16, 18, 19, 28, 29, 38, 40, 44, and 45 were previously pending. Claims 1, 4, 9, 10, 38, and 40 have been amended. Claim 8 has been cancelled. In view of the amendments above and the remarks that follow, Applicants respectfully request reconsideration.

Request to Correct Inventorship

On October 1, 2004, a Request to Correct Inventorship was filed to add Yang Wook SON as an inventor for this application. We contacted the Office of Petitions on August 2, 2006 and was informed by Thu Nguyen that the petition would be reviewed once it was assigned to an Examiner around November 2006. We are requesting that the Request to Correct Inventorship be reviewed and an Acceptance of Petition and Corrected Filing Receipt be issued with the next Office Action.

Allowable Subject Matter

Noted with appreciation is the indication in the Office Action that Claims 8-10 are all considered to be allowable. Claim 8 has been cancelled and the allowable subject matter has been amended into claim 4. Thus, claim 4 and claims 5-7, 9-12, 15, 16, 18, 19, 28, and 29 which depend from and further limit claim 4 are now in condition for allowance.

Rejections Under 35 U.S.C. §102

Independent claims 1, 4, 38, and 40 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,893,889 to Harrington. ("the Harrington patent"). The PTO provides in MPEP §2131 that, "[t]o anticipate a claim, the reference must teach every element of the claim. . ." Therefore, with respect to amended independent claims 1, 4, 38, and 40 to sustain this rejection the Harrington patent must contain all of the elements of the claims.

Claim 1

With respect to amended claim 1, the Harrington patent does not appear to disclose a vertebral implant apparatus comprising:

. . . a core member positioned between an outer body and an inner body, the outer body comprising a chamber for housing the core member and the inner body comprising a shaft extending at least partially into the

chamber, wherein the outer body is movably engaged with the inner body;
and

a first retention member on the outer body and a second retention member on the inner body, *the first retention member movably engaged with the second retention member to retain the shaft in the chamber . . .*

Therefore, the rejection of claim 1, as amended, is not supported by the Harrington patent and should be withdrawn. Claims 2 and 3 depend from and further limit claim 1 and, therefore, are also in condition for allowance.

Claim 4

As indicated above, claim 4 has been amended to incorporate the allowable subject matter of claim 8. Thus, claim 4 and claims 5-7, 9-12, 15, 16, 18, 19, 28, and 29 which depend from and further limit claim 4 are now in condition for allowance.

Claim 38

With respect to amended claim 38, the Harrington patent does not appear to disclose a kit comprising:

. . . a first outer body having a first chamber and a first retaining member;
a shaft having a second retaining member to moveably engage the first retaining member as the shaft moveably engages the first chamber;
a first core member sized and shaped to occupy a portion of the first chamber.

Therefore, the rejection of claim 38, as amended, is not supported by the Harrington patent and should be withdrawn.

Claim 40

With respect to amended claim 40, the Harrington patent does not appear to disclose
inserting the shaft into the cavity to retain the at least one core,
wherein the at least one outer member is movably engaged with the at least one inner member; and

inserting a tab into an elongated slot to limit the movable
engagement of the at least one outer member with respect to the at least
one inner member.

Therefore, the rejection of claim 40, as amended, is not supported by the Harrington patent and should be withdrawn. Claims 44 and 45 depend from and further limit claim 1 and, therefore, are also in condition for allowance.


Conclusion

It is clear from all of the foregoing that claims 1-7, 9-12, 15, 16, 18, 19, 28, 29, 38, 40, 44, and 45 are in condition for allowance. The Examiner is invited to phone the Applicant's representative at number listed below to resolve any open issues which the Examiner has identified.

No fees, including extension of time fees, are believed necessary for consideration of the present paper. However, if any fees, including extension of time fees, are necessary, the extension of time is hereby requested, and the Commissioner is hereby authorized to charge any fees, including those for the extension of time, to Haynes and Boone, LLP's Deposit Account No. 08-1394.

An early formal notice of allowance of claims 1-7, 9-12, 15, 16, 18, 19, 28, 29, 38, 40, 44, and 45 is requested.


Respectfully submitted,


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I hereby certify that this correspondence is being file with the
United States Patent and Trademark Office via EFS-Web on
February 22, 2007.


Gayle Conner